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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,418

12/19/2005

Joseph McCrossan

92478-8500

6542

52044

7590

08/01/2011

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EXAMINER

HASAN, SYED Y

ART UNIT

PAPER NUMBER

2484

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/561,418	MCCROSSAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SYED HASAN	2484	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 47 - 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47 - 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/22/2011</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Response to Arguments**

1. Applicant's arguments with respect to claims 47 – 51 filed on 05/13/2011 have been considered but are moot in view of the new ground(s) of rejection.

Changes to claim language necessitated a new search. Fujita (US 5930450) therefore has been replaced with Yamane et al (US 6181872). Details for claim 47 are provided below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005), Annex IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four

statutory classes of Sec. 101.

Claim 49 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 49 defines “recording medium .....

In the state of the art, transitory signals are commonplace as a medium for transmitting computer instructions and thus in the absence of any evidence to the contrary and given the broadest reasonable interpretation, the scope of a “recording medium” covers a signal per se. A transitory signal does not fall within the definition of a process, machine, manufacture or composition of matter.

Examiner recommends either cancelling the claim or adding language to the claim that makes this claim statutory, e.g. “non-transitory recording medium”

This claim language needs to be supported by the specification.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 47 - 51 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yamane et al (US 6181872).

Regarding **claim 47**, Yamane et al discloses a reproduction apparatus (col 7, line

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16) comprising:

an acquire unit operable to acquire, from a recording medium, a video stream and a graphics stream (col 10, line 44 to col 11, line 8)

the video stream including a video data (col 7, line 19 – 25)

the graphics stream including a data packet ( col 23, lines 30 – 40, data packet) and a control packet (col 24, lines 12 – 20 control packet)

the data packet including graphics data and a decode time stamp and a first presentation time stamp, the decode time stamp indicating a start time of a process for decoding of the graphics data, the first presentation time stamp indicating an end time of the process of decoding (col 24, lines 51 – 63 and col 31, lines 61 – 67)

the control packet including a second presentation time stamp indicating a presentation time which is at or after the end time (col 24, lines 30 – 50)

a video decoder operable to decode the video data (col 12, lines 47 – 59) and to write the decoded video data in a video plane (col 14, line 61 to col 15, line 4)

a processor operable to (col 30, lines 18 – 21)

(i) start a process for decoding the graphics, data at the start time (col 31, line 61 to col 32, line 10) and

(ii) end the process by the end time (col 71, line 17, reproduction end time)

a controller operable to write the decoded graphics data in a graphics plane by the presentation time, the graphics plane being an area where the graphics data is rendered (col 21, lines 22 – 38 and col 24, lines 51 – 63 illustrate decoded graphics data and a display which is rendered) and

an adder operable to add the video data in the video plane and graphics data in the graphics plane (fig 3, col 12, line 47 to col 13, line 7 illustrates combining video data and graphics data and graphics data rendering has been shown above)

**Claims 48 and 49** are rejected based on claim 47 above.

**Claims 50 and 51** are rejected based on claim 47 with the added limitation of a recording apparatus as disclosed by Yamani et al (col 7, line 16 illustrates recording apparatus)

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Kikuchi et al (US 7315690) discloses recording medium, recording apparatus and recording method for recording data into recording medium, and reproducing apparatus and reproducing method for reproducing data from recording medium

Murase et al (US 5907658) discloses multimedia optical disk, reproduction apparatus and method for achieving variable scene development based on interactive control

Ando et al (US 6580869) discloses recording medium of stream data including management information used to access the stream data, and recording method and playback method of the same

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./  
07/12/2011

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2484